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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,318	11/16/2000	Mary Swaab	500991	6476

23626 7590 11/17/2003  
LEYDIG VOIT & MAYER, LTD  
6815 WEAVER ROAD  
ROCKFORD, IL 61114-8018

EXAMINER
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STAIKOVICI, STEFAN

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/714,318

Applicant(s)

SWAAB, MARY

Examiner

Stefan Staicovici

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed September 2, 2003 (Paper No. 11) has been entered. Claims 7, 14, 19 and 26 have been amended. No claims have been canceled. New claims 34-45 have been added. Claims 1-45 are pending in the instant application.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on September 2, 2003 (Paper No. 12) was filed after the mailing date of the non-final rejection on March 3, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 7-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 7, 14, 19 and 26, the newly added limitation of pigments in "free of pre-measured individual units" does not appear to have support in the original disclosure. Although

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the original disclosure appears to have support for pigments in a powder form (see page 8, lines 7-8 and Figure 1), the original does not have support for pigments in bulk form "free of pre-measured individual units," because said pigments may be counted in order to fill a certain volume, such as a measuring spoon. Claims 8-13, 15-18, 20-25 and 27-35 are rejected as dependent claims.

In claims 36-40, the newly added limitation of "without counting pellets" does not appear to have support in the original disclosure. The original disclosure never mentions "pellets" and as such, a limitation of "without pellets" does not have support in the original disclosure.

In claims 41-45, the newly added limitation of "at least one pigment in powder form" does not appear to have support in the original disclosure. The original disclosure appears to have support only for pigments in a powder form (see page 8, lines 7-8 and Figure 1), and as such, does not appear to have support for any other form in order to have a limitation of "at least one pigment in powder form."

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 7-15, 17-18, 26-28, 31, 37-38, 40, 42-43 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)).

Regarding claims 7, 14 and 26, Jean Putz *et al.* (Exhibit A) teach the claimed process of custom blending and fabricating lipstick (personal specifications of a person) according to the wishes of an end-user including, providing a molding kit having a mold, a plurality of colored ground pigments (bulk form free of pre-measured individual units) plurality of bases, mixing a selected quantity of ground (powder) pigments (see page 75), softening a lipstick wax base (see page 59), mixing said pigments with said base to form a base-pigment mixture, correcting the color shade by adding more pigments (see page 75), heating said mixture such as to pour said mixture into a mold, cooling said mixture in the mold to form said lipstick and removing said lipstick for attachment to a lipstick case (see Figures on page 93). It should be noted that whether the lipstick is made at a retail establishment or at the home of an end-user of said lipstick appears to be a functional limitation. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art. Furthermore, it should be noted that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of making a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional limitation.

In regard to claim 8, Jean Putz *et al.* (Exhibit A) teach pouring a liquefied base/pigment mixture into a mold. Further, Jean Putz *et al.* (Exhibit A) teach solid pigments and a wax base that has a melting temperature of 86°C (see page 59). It is submitted that heating of the mixture occurs in order to obtain a pourable liquid as shown in the Figures on page 93 of Jean Putz *et al.*

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(Exhibit A). Furthermore, because Jean Putz *et al.* (Exhibit A) teach a stirring rod (see Figure on page 63) it is submitted that the liquefied base/pigment mixture is mixed using said Jean Putz *et al.* (Exhibit A).

Specifically regarding claim 9, Jean Putz *et al.* (Exhibit A) teach using a plurality of different pigments in order to obtain a customized color shade (see page 75).

Regarding claims 10 and 18, teach a selected quantity of ground (powder) pigments (see page 75). Since, Jean Putz *et al.* (Exhibit A) specifically teach mixing of said ground (powder) pigments with a base, it is submitted that mixing occurs on a blending sheet since a powder is spread during mixing.

In regard to claim 11, Jean Putz *et al.* (Exhibit A) teach the use of a metered dose system because Jean Putz *et al.* (Exhibit A) teach specific “recipes” that one must follow including specific quantities of pigment and/or base needed that are measured using a measuring spoon (see pages 75-76).

Specifically regarding claims 15, Jean Putz *et al.* (Exhibit A) teach pouring a liquefied base/pigment mixture into a mold in the home of the end-user and as such, it is submitted that an electrical heating device found in the home of the end-user (*i.e.*, stove) is to be used to form a liquefied mixture as taught by Jean Putz *et al.* (Exhibit A).

Regarding claims 12-13, 17 and 27-28, Jean Putz *et al.* (Exhibit A) teach removing the molded lipstick from the mold and affixing a casing prior to using said lipstick (see Figures on page 93). It should be noted that whether the lipstick is made at a retail establishment or at the home of an end-user and, the end-user waits for it to be made at the retail establishment or at home, appears to be functional limitations. In a claim drawn to a method of making, the intended

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use must result in a manipulative difference as compared to the prior art. Furthermore, it should be noted that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of making a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional limitation.

In regard to claim 31, Jean Putz *et al.* (Exhibit A) teach a plurality of bases that may be used (see pages 56-61).

Specifically regarding claims 37-38, 40, 42-43 and 45, Jean Putz *et al.* (Exhibit A) teach measuring (see page 73 describing a measuring spoon) and mixing a selected quantity of ground (powder) pigments (see page 75 describing grinding powder pigments in a mortar).

*Claim Rejections - 35 USC § 102/103*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 16 is rejected under 35 U.S.C. 102(b) as anticipated by Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) or, in the

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alternative, under 35 U.S.C. 103(a) as obvious over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) in view Collins *et al.* (US Patent No. 5,780,018).

Jean Putz *et al.* (Exhibit A) teach the claimed process as described above. Regarding claim 16, Jean Putz *et al.* (Exhibit A) teach pouring a liquefied base/pigment mixture into a mold. Further, Jean Putz *et al.* (Exhibit A) teach a process for making a lipstick in the home of the end-user. It is submitted that a microwave oven exists in the home of an end-user that is used to form a liquefied mixture as taught by Jean Putz *et al.* (Exhibit A). However, in the alternative, even if a microwave does not exist in the home of an end-user, Collins *et al.* ('018) teach a process of manufacturing customized (personal specifications of a person) lipstick (lip coloring) including, selecting a particular color shade by a customer, providing a molding kit having a mold, a plurality of pigments provided as color pellets (pigments) or a colored semi-solid paste (shapeless amorphous form) and a plurality of doses of oil blend (bases), measuring an amount of color pellets/semi-solid paste, mixing said color pellets/semi-solid paste with said oil blend, heating said mixture in a microwave oven (see col. 6, lines 27-35), pouring said mixture in a mold and cooling said mixture in said mold to form said customized lipstick. Therefore, it would have been obvious for one of ordinary skill in the art to have used a microwave oven as taught by Collins *et al.* ('018) to obtain a liquefied base/pigment mixture in the process of Jean Putz *et al.* (Exhibit A) because, Collins *et al.* ('018) specifically teaches that a microwave oven is used to obtain a liquefied pigment/base mixture having a temperature of 80-85°C, whereas Jean Putz *et al.* (Exhibit A) requires melting a wax base that has a melting temperature of 82-86 °C, hence the microwave of Collins *et al.* ('018).



*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-6, 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) in view of Beal, Jr. (US Patent No. 4,611,611).

Jean Putz *et al.* (Exhibit A) teach the basic claimed process of custom blending and fabricating lipstick according to the wishes of an end-user including, mixing a selected quantity of ground (powder) pigments (see page 75), softening a lipstick wax base (see page 59), mixing said pigments with said base to form a base-pigment mixture, correcting the color shade by adding more pigments (see page 75), heating said mixture such as to pour said mixture into a mold, cooling said mixture in the mold to form said lipstick and removing said lipstick for attachment to a lipstick case (see Figures on page 93). It should be noted that whether the lipstick is made at a retail establishment or at the home of an end-user of said lipstick appears to be a functional limitation. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art. Furthermore, it should be noted that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of making a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional limitation.

Regarding claim 1, Jean Putz *et al.* (Exhibit A) do not teach applying the mixture to the customer for evaluation. Beal, Jr. ('611) teaches an applicator to test lipstick coloring at a retail establishment (see col. 2, line 66 through col. 3, line 4). Further, it should be noted that Beal, Jr. ('611) specifically teaches the desirability of testing a lipstick color on a person's lips prior to purchasing said lipstick (see col. 1, lines 17-21). Furthermore, Jean Putz *et al.* (Exhibit A) teach correcting the color shade by adding more pigments (see page 75). Therefore, it would have been obvious for one of ordinary skill in the art to have applied the mixture to the customer for evaluation as taught by Beal, Jr. ('611) in the process of Jean Putz *et al.* (Exhibit A) because, Beal, Jr. ('611) specifically teaches the desirability of testing a lipstick color on a person's lips prior to purchasing said lipstick, Jean Putz *et al.* (Exhibit A) teach correcting the color shade by adding more pigments and also because, both references have applicability in the lipstick art.

In regard to claims 2 and 3, Jean Putz *et al.* (Exhibit A) teach pouring a liquefied base/pigment mixture into a mold. Further, Jean Putz *et al.* (Exhibit A) teach solid pigments and a wax base that has a melting temperature of 86°C (see page 59). It is submitted that heating of the mixture occurs in order to obtain a pourable liquid as shown in the Figures on page 93 of Jean Putz *et al.* (Exhibit A). Furthermore, because Jean Putz *et al.* (Exhibit A) teach a stirring rod (see Figure on page 63) it is submitted that the liquefied base/pigment mixture is mixed using said mixing rod of Jean Putz *et al.* (Exhibit A).

Specifically regarding claims 4 and 6, Jean Putz *et al.* (Exhibit A) teach removing the molded lipstick from the mold and affixing a casing prior to using said lipstick (see Figures on page 93). It should be noted that whether the lipstick is made at a retail establishment or at the home of an end-user and the end-user waits for it to be made at the retail establishment or at

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home appears to be a functional limitation. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art. Furthermore, it should be noted that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of making a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional limitation.

Regarding claim 5, Jean Putz *et al.* (Exhibit A) teach a selected quantity of ground (powder) pigments (see page 75). Since, Jean Putz *et al.* (Exhibit A) specifically teach mixing of said ground (powder) pigments with a base, it is submitted that mixing occurs on a blending sheet since a powder is spread during mixing.

In regard to claims 36 and 41, Jean Putz *et al.* (Exhibit A) teach measuring (see page 73 describing a measuring spoon) and mixing a selected quantity of ground (powder) pigments (see page 75 describing grinding powder pigments in a mortar).

12. Claims 19, 23-25, 29-30, 32-33, 39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) in view of Beal, Jr. (US Patent No. 4,611,611) and in further view of Lombardi *et al.* (US Patent No. 6,177,093 B1).

Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) teaches the basic claimed process as described above.

Regarding claims 19, 25 and 29, although Jean Putz *et al.* (Exhibit A) teach correcting the color shade generally by adding more pigments (see page 75), Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) do not specifically teach repeating the selecting, measuring and mixing steps in order to achieve the desired shade. Lombardi *et al.* ('093) teach a process for

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customizing a lipstick including, providing a customer request (selecting), measuring, mixing and heating a plurality of colored pellet material to obtain a customized color according to said request, transferring said heated material to a mold, cooling said mold and disassembling said mold to release said customized lipstick (see col. 2, line 67 through col. 3, line 14). Further, since Lombardi *et al.* ('093) teach modifying the final color based upon customer input *during the manufacturing process* (emphasis added) (see col. 3, lines 23-27) and since Lombardi *et al.* ('093) teach a customized lipstick, it is submitted that Lombardi *et al.* ('093) teach repeating the steps of selecting, measuring and mixing as described above. Therefore, it would have been obvious for one of ordinary skill in the art to have modified the final color based upon customer input during the manufacturing process (repeating the steps of selecting, measuring and mixing) as taught by Lombardi *et al.* ('093) in the process of Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) because, Lombardi *et al.* ('093) specifically teach that the color of a customized lipstick is modified according to customer input, Jean Putz *et al.* (Exhibit A) teach correcting the color shade generally by adding more pigments and also because, both all teach similar end-products and solve similar problems of providing a customized color sale to a customer/end-user. Further, it should be noted that Beal, Jr. ('611) specifically teaches the desirability of testing a lipstick color on a person's lips prior to purchasing said lipstick (see col. 1, lines 17-21). Furthermore regarding claim 19, it should be noted that the open-language "comprising" allows for heating of a base and pigment mixture and not only a base.

Regarding claim 23, Jean Putz *et al.* (Exhibit A) teach using a plurality of different pigments in order to obtain a customized color shade (see page 75). It is submitted that measuring of an amount of pigments has occurred prior to mixing said pigment/base mixture.

In regard to claim 24, Jean Putz *et al.* (Exhibit A) teach removing the molded lipstick from the clam-shell, transparent mold and affixing a casing prior to using said lipstick (see Figures on page 93). It should be noted that whether the lipstick is made at a retail establishment or at the home of an end-user and the end-user waits for it to be made at the retail establishment or at home appears to be a functional limitation. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art. Furthermore, it should be noted that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of making a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional limitation.

Specifically regarding claim 25, Jean Putz *et al.* (Exhibit A) teach pouring a liquefied base/pigment mixture into a mold. It is submitted that heating of the mixture occurs in order to obtain a pourable liquid as shown in the Figures on page 93 of Jean Putz *et al.* (Exhibit A). Furthermore, because Jean Putz *et al.* (Exhibit A) teach a stirring rod (see Figure on page 63) it is submitted that the liquefied base/pigment mixture is mixed using said mixing rod of Jean Putz *et al.* (Exhibit A) and that mixing occurs after said heating in order to be able to mix said base/pigment mixture into a uniform and homogeneous mixture.

Regarding claims 30 and 32-33, although Jean Putz *et al.* (Exhibit A) teach correcting the color shade by adding more pigments (see page 75), Jean Putz *et al.* (Exhibit A) do not specifically teach correcting said color shade after heating. Lombardi *et al.* ('093) teach a process for customizing a lipstick including, providing a customer request (selecting), measuring, mixing and heating a plurality of colored pellet material to obtain a customized color according

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to said request, transferring said heated material to a mold, cooling said mold and disassembling said mold to release said customized lipstick (see col. 2, line 67 through col. 3, line 14). Further, since Lombardi *et al.* ('093) teach modifying the final color based upon customer input *during the manufacturing process* (emphasis added) (see col. 3, lines 23-27) and since Lombardi *et al.* ('093) teach a customized lipstick, it is submitted that Lombardi *et al.* ('093) teach repeating the steps of selecting, measuring and mixing as described above. Further, it should be noted that Lombardi *et al.* ('093) teach "premixing" the components and then in view of repeating the steps of selecting, measuring and mixing as described above, Lombardi *et al.* ('093) teach "mixing" the components. Beal, Jr. ('611) teaches an applicator to test lipstick coloring at a retail establishment (see col. 2, line 66 through col. 3, line 4). Further, it should be noted that Beal, Jr. ('611) specifically teaches the desirability of testing a lipstick color on a person's lips prior to purchasing said lipstick (see col. 1, lines 17-21). Therefore, in view of the desirability to test the color of the lipstick as taught by Beal, Jr. ('611) it would have been obvious for one of ordinary skill in the art to have modified the final color based upon customer input during the manufacturing process as taught by Lombardi *et al.* ('093) in the process of Jean Putz *et al.* (Exhibit A) because, Lombardi *et al.* ('093) specifically teach the desirability of modifying the color of a customized lipstick based upon customer input, hence increasing product versatility, whereas Jean Putz *et al.* (Exhibit A) teach correcting the color shade by adding more pigments and also because, all references teach similar end products and have applicability in the lipstick art.

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In regard to claims 39 and 44, Jean Putz *et al.* (Exhibit A) teach measuring (see page 73 describing a measuring spoon) and mixing a selected quantity of ground (powder) pigments (see page 75 describing grinding powder pigments in a mortar).

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) in view of Beal, Jr. (US Patent No. 4,611,611) and in further view of Lombardi *et al.* (US Patent No. 6,177,093 B1) and Collins *et al.* (US Patent No. 5,780,018).

Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) and in further view of Lombardi *et al.* ('093) teach the basic claimed process as described above.

Regarding claim 22, although Jean Putz *et al.* (Exhibit A) teach adding Vitamin-E (anti-oxidant) (page 74), Jean Putz *et al.* (Exhibit A) in view Beal, Jr. ('611) and in further view of Lombardi *et al.* ('093) do not teach adding moisturizers and a perfume to the pigment/base mixture. Collins *et al.* ('018) teach a process of manufacturing customized (personal specifications of a person) lipstick (lip coloring) including, selecting a particular color shade by a customer, providing a molding kit having a mold, a plurality of pigments provided as color pellets (pigments) or a colored semi-solid paste (shapeless amorphous form) and a plurality of doses of oil blend (bases), measuring an amount of color pellets/semi-solid paste, mixing said color pellets/semi-solid paste with said oil blend, heating said mixture in a microwave oven (see col. 6, lines 27-35), pouring said mixture in a mold and cooling said mixture in said mold to form said customized lipstick. Further, Collins *et al.* ('018) teach adding moisturizers, an anti-oxidant and a perfume to the oil blend (base) and to the color pellet (see col. 3, lines 7-28). Therefore, it would have been obvious for one of ordinary skill in the art to have added moisturizers and a

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perfume as taught by Collins *et al.* ('018) to the pigment/base mixture in the process of Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) and in further view of Lombardi *et al.* ('093) because, Collins *et al.* ('018) teach that such ingredients are added to lipstick materials, hence such ingredients improve the quality of the resulting lipstick by providing moisturizing protection for the end-user's lips or a pleasing aroma.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) in view of Beal, Jr. (US Patent No. 4,611,611) and in further view of Lombardi *et al.* (US Patent No. 6,177,093 B1) and Applicant's Admitted Prior Art.

Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) and in further view of Lombardi *et al.* ('093) teach the basic claimed process as described above.

Regarding claim 20, although Jean Putz *et al.* (Exhibit A) teaches a measuring spoon (see page 73), Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) and in further view of Lombardi *et al.* ('093) do not teach a graduated sheet having graduated segments. However, Applicant admits on page 6, lines 1-2 and 11-13 of the original disclosure, that a measuring spoon is an equivalent alternative to a graduated sheet having graduated segments for measuring a quantity of pigments. Therefore, it would have obvious for one of ordinary skill in the art to have provided a graduated sheet having graduated segments as taught by Applicant's Admitted Prior Art as an equivalent alternative to a measuring spoon in the process of Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) and in further view of Lombardi *et al.* ('093) because, Applicant admits that a measuring spoon is an equivalent alternative to a graduated sheet having graduated segments for measuring a quantity of pigments.



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15. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) in view of Applicant's Admitted Prior Art.

Jean Putz *et al.* (Exhibit A) teach the basic claimed process as described above.

Regarding claims 34-35, although Jean Putz *et al.* (Exhibit A) teaches a measuring spoon (see page 73), Jean Putz *et al.* (Exhibit A) do not teach a graduated sheet having graduated segments. However, Applicant admits on page 6, lines 1-2 and 11-13 of the original disclosure, that a measuring spoon is an equivalent alternative to a graduated sheet having graduated segments for measuring a quantity of pigments. Therefore, it would have obvious for one of ordinary skill in the art to have provided a graduated sheet having graduated segments as taught by Applicant's Admitted Prior Art as an equivalent alternative to a measuring spoon in the process of Jean Putz *et al.* (Exhibit A) because, Applicant admits that a measuring spoon is an equivalent alternative to a graduated sheet having graduated segments for measuring a quantity of pigments.

*Allowable Subject Matter*

16. Claim 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 1732

15. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) in view of Applicant's Admitted Prior Art.

Jean Putz *et al.* (Exhibit A) teach the basic claimed process as described above.

Regarding claims 34-35, although Jean Putz *et al.* (Exhibit A) teaches a measuring spoon (see page 73), Jean Putz *et al.* (Exhibit A) do not teach a graduated sheet having graduated segments. However, Applicant admits on page 6, lines 1-2 and 11-13 of the original disclosure, that a measuring spoon is an equivalent alternative to a graduated sheet having graduated segments for measuring a quantity of pigments. Therefore, it would have obvious for one of ordinary skill in the art to have provided a graduated sheet having graduated segments as taught by Applicant's Admitted Prior Art as an equivalent alternative to a measuring spoon in the process of Jean Putz *et al.* (Exhibit A) because, Applicant admits that a measuring spoon is an equivalent alternative to a graduated sheet having graduated segments for measuring a quantity of pigments.

***Allowable Subject Matter***

16. Claim 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

17. Applicant's remarks filed September 2, 2002 (Paper No. 11) have been considered.

In view of the Supplementary Information Disclosure Statement filed on September 2, 2003 (Paper No. 12), after the mailing of the non-final rejection on March 3, 2003 (Paper No. 10), and the resulting new ground(s) of rejection, Applicant's arguments are considered moot.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Conclusion*

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396 (until December 22, 2003) and (571) 272-1208 (after December 23, 2003). The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached at (703) 305-5493. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD



Primary Examiner

11/15/03

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November 15, 2003